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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,562	09/25/2001	Bryson Gordon	NAIIP140/01.131.01	3082
28875	7590	02/24/2005	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			POLTORAK, PIOTR	
			ART UNIT	PAPER NUMBER
			2134	
DATE MAILED: 02/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/965,562	Applicant(s) GORDON ET AL.	
	Examiner Peter Poltorak	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 14-18, 31-33 and 35-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 19-30, 34 and 38-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:
 - i. A method for certifying e-mail messages free from viruses:
1-13, 19-30
 - ii. A method for certifying instant messages free from viruses:
35-37
 - iii. A method for certifying hosted site content free from viruses:
14-18 and 31-33
2. Claims 34, 38-41 are generic.
3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as

provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP §09.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. A telephone call was made to Kevin Zilka (408-971-2573) on 2/8/05 to request an oral election to the above restriction requirement. Group I (*claims 1-13 and 19-30*) has been elected with traverse.
5. Claims 1-13 and 19-30, 34 and 38-41 have been examined.

Claim Rejections - 35 USC § 101

6. Claims 19-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 19-30 are product claims implementing computer readable medium. The application suggests that the computer readable medium can be a carrier wave (e.g. claim 28). A carrier wave is non-tangible and as a result the claims are considered to be directed towards abstract ideas and are not statutory.

Claim Rejections - 35 USC § 112

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 5, 7, 27, 34 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.
8. The term: "it" in claims 1, 27 and 34 is not understood. The term is treated as "the e-mail".
9. The term "when" in claims 5 and 38 is not understood. It is not clear whether "automatically scanning the e-mail when a user sends the e-mail" limits the e-mail scanning being automatically triggered at the time when user sends (e.g. press a send button) e-mail or it simply refers to the fact that e-mail sent by the user is automatically scanned. In other words it is not clear whether the scanning must be almost instantaneous upon user indicating e-mail to be sent or whether the limitation allows for a short delay e.g. e-mail is sent to the server which automatically handles e-mail scanning.
10. The term "describing" in claim 7 is not understood.
11. Claims 2-4, 6, 8-13 and 38-41 are rejected by virtue of their dependence.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 6-7, 19-20, 27, 34 and 39 are rejected under 35 U.S.C. 102(b) as

anticipated by AVG (*AVG anti-virus*) as evidenced by *Suffolk-L*

(<http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114>),

Microscopy (*Microscopy ListServer Archives*,

<http://www.msa.microscopy.com/cgi->

[bin/ReadPrintEmailHTML.pl?filename=9905.txt](#), 2nd e-mail) and Listserv

(<http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag->

[I&F=&S=&P=2411](#), 2nd e-mail).

13. As per claim 1 AVG provides a certificate added to e-mail sent from a

computer to a recipient (*e.g. in Suffolk-L, the e-mail from A.G. Forman*), the

certificate identifying the e-mail as being scanned for viruses and certifying

that no viruses were found (*the bottom of e-mails: "Outgoing mail is certified*

Virus Free". Checked by AVG..." etc.).

14. Claims 19, 27 and 37 are substantially equivalent to claim 1; therefore claims

19, 27 and 37 are similarly rejected.

15. As per claim 7, as best understood, AVG discloses a web link

(<http://www.grisoft.com>).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2-3, 5, 21-24, 28-29 and 38 are rejected under 35 U.S.C. 103(a) as

being unpatentable over AVG (AVG anti-virus) as evidenced by *Suffolk-L*

(<http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114>),

Microscopy (*Microscopy ListServer Archives*,

[http://www.msa.microscopy.com/cgi-](http://www.msa.microscopy.com/cgi-bin/ReadPrintEmailHTML.pl?filename=9905.txt)

[bin/ReadPrintEmailHTML.pl?filename=9905.txt](http://www.msa.microscopy.com/cgi-bin/ReadPrintEmailHTML.pl?filename=9905.txt), 2nd e-mail) and *Listserv*

([http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-](http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-I&F=&S=&P=2411)

[I&F=&S=&P=2411](http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-I&F=&S=&P=2411), 2nd e-mail) in view of *Official Notice*.

17. AVG teaches an e-mail certificate as discussed above.

18. As per claim 2 AVG does not explicitly teach the e-mail being created using a desktop mail application.

Official Notice is taken that it is old and well-known practice to create an e-mail using a desktop mail application, (e.g. Outlook). One of ordinary skill in the art at the time of applicant's invention would be motivated to employ a desktop mail application to take advantage of desktop mail application's usability.

19. As per claims 3 and 21-22 AVG does not explicitly teach that the sending and receiving computers are desktop computers or handheld computers.

However, the choice of using a desktop or handheld computers to send or receive e-mail would have been obvious to one of ordinary skill in the art given that it is well known and barring any unexpected results to the contrary.

20. As per claim 23 AVG does not explicitly teach that the computers sending and receiving e-mail are servers located within a computer network. Official Notice is taken that it is old and well-known practice to utilize servers to send and receive e-mail (*e.g. Microsoft Exchange, on line e-mail servers etc.*). One of ordinary skill in the art at the time of applicant's invention would be motivated to employ servers to send and receive e-mail to take advantage of multiple benefits of client server environment in e-mail environment, for example allowing sender and receiver to communicate while they travel. The limitation: "sending and receiving servers being located within a computer network" is implicit. E-mail is exchanged between entities within a network (*e.g. Internet entities*).

21. As per claim 24 AVG does not teach certificates that contain only graphical images.

Official Notice is taken that it is old and well-known practice to use certificates containing only graphical images (*e.g. Security Metrics Certified, BBBOnline, SSL locks etc.*). One of ordinary skill in the art would have been motivated to perform such a modification in order to simplify the identification of the certificate and prevent altering of the certificate.

22. As per claim 28 AVG does not explicitly teach that the computer codes (implementing the invention) are stored on a medium selected from the group

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consisting of CD-ROM, floppy disk, tape, flash memory, system memory or a hard drive.

Official Notice is taken that it is old and well-known practice to use CD-ROM, floppy disk, tape, flash memory, system memory or a hard drive as a medium giving the benefit of inexpensive and proven/reliable technology.

23. As per claim 29 AVG does not explicitly teach cleaning infecting data.

Official Notice is taken that it is old and well-known practice to clean infecting data. One of ordinary skill in art at the time of applicant's invention would be motivated to clean infected data to prevent computer problems.

24. Claims 4 and 11-13 are rejected under 35 U.S.C. 103(a) as being

unpatentable over AVG (AVG anti-virus) as evidenced by *Suffolk-L*

(<http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114>),

Microscopy (Microscopy ListServer Archives,

<http://www.msa.microscopy.com/cgi->

[bin/ReadPrintEmailHTML.pl?filename=9905.txt](http://www.msa.microscopy.com/cgi-bin/ReadPrintEmailHTML.pl?filename=9905.txt), 2nd e-mail) and Listserv

(<http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag->

[I&F=&S=&P=2411](http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-I&F=&S=&P=2411), 2nd e-mail) in view of *Chen et al.* (U.S. Patent No.

5832208).

25. AVG teaches e-mail certified as being free of viruses as discussed above.

26. As per claim 4 AVG does not explicitly teach scanning attachments contained within the e-mail.

Chen et al. teach scanning e-mail attachments (*Chen et al., Abstract*). It

would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to incorporate scanning e-mail attachments. One of ordinary skill in the art would have been motivated to perform such a modification in order to avoid computer problems (*Chen et al.*, col. 1 lines 39-52).

27. As per claim 11 *Chen et al.* teach the computer being a network server (col. 4 lines 13-30). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use a network server as taught by *Chen et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to avoid the necessity of installing anti-virus software on all workstations.

As per claim 12 and 13 scanning e-mail for viruses and attaching certificate at the server would be implicit.

28. Claims 5 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over AVG (AVG anti-virus) as evidenced by *Suffolk-L* (<http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114>), *Microscopy* (*Microscopy ListServer Archives*, <http://www.msa.microscopy.com/cgi-bin/ReadPrintEmailHTML.pl?filename=9905.txt>, 2nd e-mail) and *Listserv* (<http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-I&F=&S=&P=2411>, 2nd e-mail) in view of ACS (ACS Microcomputer Workshop, "Message management in Outlook for Windows", 1999)

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29. AVG teaches scanning and sending e-mail as discussed above. AVG does not explicitly teach the e-mail being scanned automatically when user sends the e-mail.

ACS teaches automatic scanning (*default spell check option*) when e-mail is sent (*Spell Checking a message*).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to scan e-mail automatically when user sends the e-mail as taught by ACS. One of ordinary skill in the art would have been motivated to perform such a modification in order to take advantage of a main computing strong points: tasks automation.

30. Claims 8-10, 26, 30 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over AVG (AVG anti-virus) as evidenced by *Suffolk-L* (<http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114>), *Microscopy* (*Microscopy ListServer Archives*, (<http://www.msa.microscopy.com/cgi-bin/ReadPrintEmailHTML.pl?filename=9905.txt>, 2nd e-mail) and *Listserv* (<http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-I&F=&S=&P=2411>, 2nd e-mail) in view of *Fisher* (U.S. Patent No. 5311591).

31. AVG teaches attaching a certificate if no viruses are found as discussed above.

AVG does not teach attaching a digital signature and does not teach that the recipient verifies that the e-mail has not been tampered with.

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Fisher teaches attaching a digital signature and teaches a content recipient verifying that no tampering occurred (*Fisher*, col. 16 lines 9-23). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to attach a digital signature and verify that content has not been tampered with. One of ordinary skill in the art would have been motivated to perform such a modification in order to verify that no virus infection occurred (*Fisher*, col. 16 lines 9-23).

32. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over AVG (AVG anti-virus) as evidenced by *Suffolk-L* (<http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114>), *Microscopy* (*Microscopy ListServer Archives*, <http://www.msa.microscopy.com/cgi-bin/ReadPrintEmailHTML.pl?filename=9905.txt>, 2nd e-mail) and *Listserv* (<http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-I&F=&S=&P=2411>, 2nd e-mail) in view of *Fegghi et al.* (*Jalal Fegghi, Jalil Fegghi and Peter Williams "Digital Certificates, Applied Internet Security", 1998, ISBN: 0201309807*).

33. AVG teaches certificate as discussed above. AVG does not teach certificate containing graphics and text.

Fegghi et al. teach a certificate containing graphics and text (*Fegghi et al.*, pg. 151 Fig. 5-21). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize the certificate containing graphics and text as taught by *Fegghi et al.* One of ordinary skill in the art would have

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been motivated to perform such a modification in order to clearly identify the certificate and provide additional information pertaining the certificate while limiting space used (*text takes less space than graphics*).

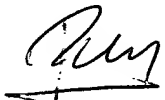
Conclusion

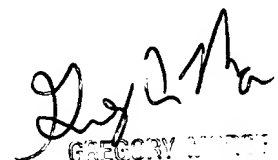
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Spear (U.S. Patent No. 6611925)*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Signature
4/17/05
Date


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SUPERVISORY PATENT EXAMINER
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